UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,797	12/20/2001	Ernest Marvin Thiessen	ICANS2/WAB	4804

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EXAMINER
CHENCINSKI, SIEGFRIED E

ART UNIT	PAPER NUMBER
3691	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/022,797	THIESSEN ET AL.
	Examiner	Art Unit
	SIEGFRIED E. CHENCINSKI	3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 May 2008</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>18-29</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>18-29</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1.   **Claims 18-29 are rejected under 35 U.S.C. 101** because the claimed invention is not supported by either a tangible asserted utility, a concrete asserted utility or a well established utility. 1) regarding tangibility, independent claim 18 and dependent claims 21, 24, 26, 27 and 28 fail to produce a concrete result by containing the limitation "other information" and "other suggestions" which is indefinite. Further, 2) the lack of tangibility in independent claim 18 impacts dependent claims 19-29, which depend on independent claim 18.

        Applicant is advised to satisfy the statutory requirements for the claims. Applicant is also advised not to add any new matter to the specification or the claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2.   **Claims 18-29 are also rejected under 35 U.S.C. 112, first paragraph.** Specifically, since the claimed invention is not supported by either a tangible asserted utility, a concrete result or a well established utility for the reasons set forth above in the rejection under 35 USC 101, one skilled in the art clearly would not know how to use the claimed invention.

3.   **Claims 18-29 are rejected under 35 U.S.C. 112, first paragraph**, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the
invention because the specification contains methods and guidelines which can only be
implemented in a subjective manner, thus preventing two ordinary practitioners of the
art working independently from the possibility of duplicating the results of one another.
Further, independent claim 18 requires numerous subjective decisions to be made by
the participants and by the moderator and the moderator system. Dependent claims 19-
29 are similarly indefinite. Dependent claims 21, 24, 26, 27 are also indefinite. Also, the
participants are not required to make inputs and/or specific decisions. The dependent
method claims merely add detailed steps within the uncertain process.

Regarding independent claim 18, the judgments in each step represented by Figures 2
through 10 which are part of the guidelines to the practitioner for performing the
generation of potential agreements by the participants in the process can only be made
in a subjective manner. If the history of observed human behavior is a guide, the same
individuals are likely to make different decisions in different sessions. Their own mental
and emotional state will differ during different times. Their feelings of friendliness or
antagonism, optimism or pessimism, compliance, rebelliousness or assertiveness level
will fluctuate. In a sales or cost management scenario, these factors will affect their view
of how successful they will be in an example of selling goals and budget will fluctuate.
This is why many union-management agreements are arrived at in the early hours of
long negotiation sessions when the negotiators on both sides are weary and more
prone to agree to something just so they can go home and get some much needed
sleep and also bring back a result to their superiors and/or stake holders.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claims 18-29 are rejected under 35 U.S.C. 112, second paragraph, because
numerous terms in the claims are relative terms which render the claims indefinite.
Independent claim 18 lacks concreteness and tangibility because the there are not
concrete or tangible bounds to the proposals and suggestions, parameters for

agreement, issues to be resolved and parameters for indications of agreement by the parties in the negotiation. This affects all of the claims depending on independent claim 18. Regarding dependent claims 20, 25, 26 and 27, the terms "level of satisfaction" and "preferences" are relative terms which render the claim indefinite as are the terms "other information" and "other suggestions" in claims 21, 24, 26, 27 and 28. The terms " level of satisfaction " and "preferences" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Further, in independent claim 18, it is unclear that the stated goal in element a) of generating "at least one potential agreement" is guaranteed to be achieved. It is unclear how each party's preferences will be expressed (element b)). Regarding element d), it is unclear how potential agreements will be evaluated.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5.   Claims 18-29 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,495,412. Although the conflicting claims are not identical, they are not patentably distinct. Applicant's specification supports these grounds for nonstatutory obviousness-type double patenting because Applicant admits in the specification that the instant application is based on the invention of Patent No. 5,495,412, but that it differs through the addition of an "improvement" by adding the feature which "allows decision makers to use blind bidding" (Specification, p. 3, ll. 27-28; p. 6, ll. 1-2). Aggarval et al. (US Patent 6,151,589) discloses the use of blind bidding prior to Applicant's invention. However, Applicant has not claimed this improvement. This makes the current claims mere rewordings of the claims.

Claim 18 in the application and claim 1 in the patent are each concerned with a computer-based method for assisting at least two parties in a negotiation making use of at least one programmed computer. Claim 18 of the application and claim 20 of the patent are each concerned with a computer-based method for assisting at least two parties in a negotiation making use of a plurality of programmed computers ("one or more" in claim 18 vs "at least one" in the patent's claim 1 and "a plurality of computers" in the patent's claim 20, each independent from each other and each connected to a common separate central computer located at a neutral site). The claims in the parent patent make use of the Pareto optimal principle in independent claims 1(c) ii and 20 (g) and in dependent claim 16 ii). The Application's current claims make use of optimization in dependent claims 24 and 26, which makes explicit the method in the specification for "b) generating with at least one of said computers one or more suggestions that are based on said received proposals and seek to provide at least one potential resolution to the negotiation" and "generating an indication" in current independent claim 18 for reaching an agreement. Current claim 18 claims that the facilitator computer receives one or more proposals for agreement from the participating parties in the negotiation regarding the one or more issues to be resolved. Patent claim 1 claims "said computer system being programmed to generate at least one proposed agreement on decisions to be taken on one or more of said issues of said negotiation problem in response to

entered preference data from each of said parties" and claim 20 claims "said central computer system being programmed to receive preference information from each of said independent, separate computer systems and generate at least one proposed agreement to the negotiation problem in response to entered preference information from each of said independent, separate computer systems". The other procedural communications details in current claim 18 and its deendencies are similar to those in the patent's claims 1 and 20 and the claims depending thereof. Therefore, an ordinary practitioner of the art at the time of Applicant's invention would have seen it as obvious to reword the claims of the patent and to move the optimization features to dependent claims in order to produce the current application's claims. Further, the rejections on the merits of this application's claims are entirely based on the instant parent patent.

Claim Rejections - 35 USC § 102

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.   **Claims 18-29 are rejected under 35 U.S.C. 102(b)** as being anticipated by Thiessen (U.S. Patent No. 5,495,412).

Re. Claim 18, Thiessen anticipates a computer executable method for resolution of a negotiation between two or more parties including one or more issues to be resolved, operative to control one or more computers and stored on at least one computer readable medium, the method when executed by said one or more computers comprising the steps of:

a) receiving in at least one of said computers one or more proposals for agreement from each of said parties in said negotiation regarding the one or more issues to be resolved (Computers – Abstract, II. 5-10; Receiving proposals – Col. 5, II. 42-50);

b) generating with at least one of said computers one or more suggestions that are based on said received proposals and seek to provide at least one potential resolution to the negotiation (Col. 5, II. 52-58);

c) providing each of said suggestions to each of said parties (col. 5, II. 58-60);

d) receiving in confidence in at least one of said computers from each of said parties an indication as to whether that party accepts one or more of said suggestions AbstractOll. 14-16; Col. 3, ll. 37-38; Col. 7, ll. 19-26; Col. 10, ll. 27-28); and

e) generating an indication with at least one of said computers that said parties have reached an agreement if all said parties accept one or more of the same said suggestions (Abstract – ll. 24-25; Col. 10, ll. 38-39, 47-49), but if not, generating an indication with at least one of said computers that said parties have not reached an agreement (Fig. 2B – STOP points; Col. 10, ll. 43).

Re. Claim 19, Thiessen anticipates wherein the step of receiving in at least one of said computers one or more proposals for agreement from each of said parties in said negotiation regarding the issues to be resolved is carried out by entering said proposals into at least one of said computers using an interactive graphical interface in communication with at least one of said computers (Col. 3, ll. 55-57; col. 7, ll. 42-46).

Re. Claim 20, Thiessen anticipates wherein said proposals for agreement are accompanied by information defining each party's preferences on the outcome of the one or more issues, and said one or more suggestions generated by at least one of said computers are also based on said preferences and define said suggestions in terms of a specified level of satisfaction for each party on each issue according to said preferences (Fig. 2A, Col. 5, ll. 44-46; Col. 6, ll. 17-21, 63-66).

Re. Claim 21, Thiessen anticipates generating said one or more suggestions based on other previously generated suggestions (Col. 3, ll. 22-35; col. 7, ll. 17-28).

Re. Claim 22, Thiessen anticipates wherein the step of receiving in at least one of said computers one or more proposals for agreement from each of said parties in said negotiation regarding the one or more issues to be resolved further includes receiving in at least one of said computers from any party to the negotiation, private suggestions that are indistinguishable from said suggestions that are computer generated; and said step of providing each of said suggestions to said parties comprises providing each of said computer generated suggestions and each of said private suggestions to said parties (Col. 3, ll. 52-67; Col. 4, ll. 45-50, 59-63; Col. 5, ll. 41-60).

Re. Claim 23, Thiessen anticipates wherein said negotiation includes multiple issues to be resolved and said method further includes the step of entering into at least one of said computers through said graphical interface, tradeoff preference information that defines the relative importance to each of the parties for each of the issues (Col. 6, ll. 1-29; Col. 5, ll. 41-46; Col. 7, ll. 42-43).

Re. Claim 24, Thiessen anticipates further including the steps of

a) entering detailed tradeoff and satisfaction function preference information or other information from which that information may be derived (Col. 5, ll. 43-36);

b) analyzing those preferences to determine said specified satisfaction levels more precisely (Col. 5, ll. 52-55);

c) using optimization techniques to generate an improved suggestion that is Pareto optimal according to said entered preferences (Col. 6, ll. 56-57); and

d) displaying said improved suggestion on said graphical interface (Col. 5, l. 34).

Re. Claim 25, Thiessen anticipates further including the steps of:

a) entering into at least one of said computers changed preference information, said preference information including any of acceptance of proposals or suggestions; retraction of previous acceptances; and different proposals or suggestions; and b) in response to said entering of said changed preference information, at least one of said computers generating one or more new suggestions (col. 3, ll. 11-17; Col. 7, ll. 19-28).

Re. Claim 26, Thiessen anticipates wherein said step in response to said entering of said changed preference information, of at least one of said computers generating one or more suggestions further comprises:

a) identifying a plurality of proposals or suggestions, one for each of said parties, each said proposal or suggestion being acceptable to its corresponding party and providing a specified level of satisfaction for that party (Col. 3, ll. 11-17; col. 5, ll. 58-60);

b) if said plurality of proposals or suggestions are not identical to one another, generating a suggestion that is different from said plurality of proposals or suggestions (Col. 5, ll. 55-56), using optimization techniques to analyze said preference information and provide a level of satisfaction for each said party that is at least as great

as the level of satisfaction provided by each said party's acceptable proposal or
suggestion (Col. 6, l. 57; Col. 3, ll. 62-64; Col. 7, ll. 17-28); and,

c) displaying said generated suggestion on said interactive graphical interface for
consideration together with other suggestions for agreement (Col. 5, ll. 33-34).

Re. Claim 27, Thiessen anticipates wherein a plurality of independent, separate
computer systems is provided, one each for each of said parties, each said
independent, separate computer system being programmed to receive and process
information from each party, including that pertaining to each of said party's preferences
on the outcome of each said issue involved in said negotiation (col. 3, ll. 18-20; Fig. 1;
Col. 3, ll. 27-34); and,

a central computer system located at a neutral site is provided that is programmed
to receive preference information from each of said independent, separate computer
systems, generate at least one suggestion for agreement in response to entered
preference information from each of said independent, separate computer systems, and
securely transmit generated information and other information to be communicated
between parties; wherein, the information pertaining to each of said party's preferences
remains confidential to each party (Fig. 1, Col. 3, ll. 49-60; Col. 5, ll. 50-52).

Re. Claim 28, Thiessen anticipates wherein a plurality of independent,
separate computer systems is provided, one each for each of said parties, each said
independent, separate computer system being programmed to receive and process
information from each party, including that pertaining to each of said party's preferences
on the outcome of each said issue involved in said negotiation; and a central computer
system located at a neutral site is provided that is programmed to receive preference
information from each of said independent, separate computer systems, generate at
least one suggestion for agreement in response to entered preference information from
each of said independent, separate computer systems, and securely transmit generated
information and other information to be communicated between parties; wherein, the
information pertaining to each of said party's preferences remains confidential to each
party (Col. 5, ll. 26-60).

Re. Claim 29, Thiessen anticipates wherein the step of receiving in at least one of said computers one or more proposals for agreement from each of said parties in said negotiation regarding the one or more issues to be resolved further includes receiving in at least one of said computers from any party to the negotiation, private suggestions that are indistinguishable from said suggestions that are computer generated; and said step of providing each of said suggestions to said parties comprises providing each of said computer generated suggestions and each of said private suggestions to said parties (Col. 6, ll. 27-35. The reference teaches sending anonymous suggestions and recommendations to the parties such that confidential suggestions and ideas from the negotiating parties and suggestions and ideas from the facilitator are indistinguishable from each other because their origin is not identified.).

Response to Arguments

7.   Applicant's arguments submitted on May 5, 2008 with respect to claims 18-29 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Siegfried Chencinski whose telephone number is

(571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to

6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

supervisor, Alexander Kalinowski, can be reached on (571) 272-6771.

Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
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or Faxed to (571*)273-8300* [Official communications; including After Final

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or Faxed to *(571) 273*-6792 [Informal/Draft communications, labeled

"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above

USPTO web site in Alexandria, VA.

SEC

August 11, 2008

/Narayanswamy Subramanian/
Primary Examiner, Art Unit 3691